

09-12-06

AF
ZPW

Express Mail Label No. EL 969354271 US Dated: September 11, 2006

Docket No.: SONY 3.0-027
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Siegel et al.

Application No.: 09/726,973

Group Art Unit: 2154

Filed: November 30, 2000

Examiner: K. S. Lin

For: HOST SITE BASED INTERNET TRAFFIC
METER

TRANSMITTAL

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:


Enclosed herewith is an Amended Appeal Brief in response to the Notification of Non-Compliant Appeal Brief dated August 31, 2006.

Applicants believe that no fees are due. However, if there are any additional charges in connection with this requested Amended Appeal Brief, the Commissioner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 11, 2006

Respectfully submitted,

By


Raymond B. Churchill, Jr.
Registration No.: 44,617
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant



Express Mail Label No. EL 969354271 US Dated: September 11, 2006

Docket No.: SONY 3.0-027
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Siegel et al.

Application No.: 09/726,973

Group Art Unit: 2154

Filed: November 30, 2000

Examiner: K. S. Lin

For: HOST SITE BASED INTERNET TRAFFIC
METER

AMENDED APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby file this brief on Appeal to appeal from the final rejection of claims 1-18 mailed August 19, 2006, and in response to the Advisory Action mailed January 27, 2006. This amended brief is submitted in response to the Office Action dated August 31, 2006.

REAL PARTIES IN INTEREST

The real parties in interest in this case are the assignees of record: Sony Corporation, a Japanese corporation, having a place of business at 7-35 Kitashinagawa 6-Chome, Shinagawa-ku, Tokyo, Japan; and Sony Electronics Inc., a New Jersey corporation, having a place of business at 1 Sony Drive, Park Ridge, New Jersey 07656. The assignment of the present application to Sony Corporation and Sony Electronics Inc. was

recorded in the United States Patent and Trademark Office on February 26, 2001 at Reel 011598, Frame 0764.

RELATED APPEALS AND INTERFERENCES

At present, there are no other appeals or interferences known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-18 are pending in the present application. Claims 1-18 were rejected in a final office action and such final rejection of claims 1-18 is being appealed.

Independent claims

Independent claims 1 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Mitchell (U.S. Published Application 2002/0013850) ("Mitchell") in view of Haitsuka (U.S. Patent No. 6,847,992) ("Haitsuka").

Dependent Claims

Dependent claims 2, 4-7, 13, 16 and 17 have also been rejected as obvious over Mitchell in view of Haitsuka. Dependent claim 3 stands rejected as in claim 1 in further view of U.S. Patent No. 6,701,362 to Subramonian. Dependent claims 8-12 stand rejected as in claim 1 in further view of "Official Notice." Dependent Claim 18 has been rejected as in claim 17 in further view of U.S. Patent No. 6,836,799 to Philyaw. Dependent Claim 14 has been rejected as in claim 13 in further view of U.S. Patent No. 6,606,581 to Nickerson.

STATUS OF AMENDMENTS

A final office action rejecting claims 1-18 was mailed on August 19, 2005. A response to the Final Action was filed on December 19, 2005. The response did not cancel or amend any of the claims that are the subject of this appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

As recited in independent claim 1, Appellant's invention is directed to a method of personalizing information presented at a host web site. The method includes assigning a unique ID to each device among a plurality of devices used for presenting the personalized information. (See, e.g., Applicant's Specification at ¶ 9; FIG. 3.) A host web site is used for obtaining personal data about a user during a visit to the host web site. (See, e.g., Applicant's Specification at ¶ 8; FIG. 2, 3.) After the host web site obtains the personal data about the user, the host web site is used for monitoring the content of information viewed by a user while the user visits other web sites. (See, e.g., Applicant's Specification at ¶ 10; FIG. 2.) During a subsequent visit by the user to the host web site, the information presented to the user is personalized, wherein the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the personal data obtained about the user and the content of the other web sites visited by the user. (See, e.g., Applicant's Specification at ¶ 6, 12; FIG. 2) The content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices. (See, e.g., Applicant's Specification at ¶ 9; FIG. 2)

Applicant's invention of independent claim 15, which may be compared with independent claim 1, is a method of personalizing

information presented to a user of a host web site. In the method a unique ID is assigned to each device among a plurality of devices used for presenting the personalized information. The host web site is used for collecting identifying data about the user during a first visit to the host web site. After the host web site collects the identifying data, the host web site is used for monitoring the content of information viewed by the user while the user visits other web. During a subsequent visit by the user to the host web site, the information presented to the user is personalized, such that the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the identifying data collected about the user and the content of the other web sites visited by the user. Thus, the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

For example, a user will visit a host web site, such as the web site having the domain name SONYSTYLE.COM, owned and operated by Sony Electronics of America. At the host web site, the user will be queried as to whether he or she wishes to complete a personal data registration form so as to register with the host web site. The user's activities are tracked so that the host web site may gather information about the user's interests and preferences. As a result, when the user returns to the host web site at a future date, the content of the information displayed to the user will be modified so that the content of the information substantially matches the user's interests and/or personal demographic data. (See, e.g., Applicant's Specification at ¶ 7; FIG. 2, 3)

If the user does complete the personal data registration form, then the host web site will transmit a cookie to the user's hardware. The cookie may be stored in the user's

hard drive. The user will then complete the personal data registration form that preferably includes information such as the user's name, address, zip code, telephone number, e-mail address, age and occupation. As the user completes the personal data registration form, the personal data will be recorded on the user's cookie. The data recorded on the cookie will be transmitted to the host web site. The cookie information including the personal data is preferably recorded in one or more databases maintained by the host web site so that the information can be retrieved and updated each time a user accesses the host web site. (See, e.g., Applicant's Specification at ¶ 8.)

In this process, the user is assigned a unique identity that is linked to the personal computer (PC) used to access the host web site. For example, a user may visit business related web sites from a first PC at work and entertainment related sites from a second PC at home. The host web site of the present invention desirably assigns a first cookie to the user's work PC and a second cookie to the user's home PC. The cookie assigned to the work PC will track and monitor the web sites that the user visits at work. This information will be stored in a database maintained by the server of the host web site. The cookie assigned to the home PC will track and monitor the web sites that the user visits at home. This information will also be stored by the server of the host web site. The information stored about usage of the work PC will have a different content than the information stored on usage of the home PC. As a result, the user's experience when visiting the host web site may be very different depending upon which PC is utilized to visit the host web site. (See, e.g., Applicant's Specification at ¶ 9; FIG. 2)

When the user returns to the host web site, the host web site will retrieve information from the user's cookie so as

to identify the identity of the user. The host web site will then compare the information retrieved from the cookie with any information previously stored at the host web site. The host web site will then update its profile for the user, if necessary, including any subsequent web surfing activities recorded on the user's cookie. The host server supporting the web site may also record any changes in the user's personal data. The personal data and updated user interest profile will then be used to compile a personalized web page that reflects the user's interests and/or personal data. In other words, the content of the information presented to the user at the host web site will be modified in response to the user's interests or personal data. As a result, the host web site will transmit a web page to a user that has been modified to reflect the user's interests. Such personalized web pages will greatly enhance the user's visit to the host web site, thereby making the visit more profitable for both the user and the company/entity hosting the web site. (See, e.g., Applicant's Specification at ¶ 11; FIG. 2.)

Moreover, by monitoring the subject matter content of other web sites visited by the user, and during a subsequent visit by the user to the host web site, the personalizing of the information presented to the user can be based upon the identifying data collected from the user and the subject matter content of the other web sites visited by the user. (See, e.g., Applicant's Specification at ¶ 6; FIG. 2.)

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether or not independent claims 1 and 15 are unpatentable under 35 U.S.C. §103(a) as being obvious over U.S. Published Application 2002/0013850 to Mitchell in view of U.S. Patent No.

6,847,992 to Haitsuka and whether or not these claims and their dependent claims should be allowed.

ARGUMENT

Independent claims 1 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Mitchell (U.S. Published Application 2002/0013850) ("Mitchell") in view of Haitsuka (U.S. Patent No. 6,847,992) ("Haitsuka").

Applicant at least disagrees with the Examiner's reliance on the cited art in the rejections of these independent claims. Applicant submits that a *prima facie* case of obviousness has not been presented. The remaining claims are dependent on either claim 1 or 15 and are allowable at least for the same reasons.

As previously discussed, an embodiment of the invention is directed to a method for personalizing information presented to a user at a host web site. By way of example, the user may access the host web site from different locations such as a user's office or a user's home. The devices used at the user's office and at the user's home are each assigned a separate unique ID. The host web site monitors the content of other web sites that the user visits and on which device the user is accessing the other web sites. On subsequent visits, the host web site will present information to the user based on the assigned unique ID of the device being used and the content that was previously accessed from that device.

As detailed in claim 1, Applicants' invention includes:

assigning a unique ID to each device among a plurality of devices used for presenting the personalized information;

using the host web site for obtaining personal data about a user during a visit to the host web site;

after the host web site obtains the personal data about the user, using the host web site for monitoring

the content of information viewed by the user while the user visits other web sites; and

during a subsequent visit by the user to the host web site, personalizing the information presented to the user, wherein the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the personal data obtained about the user and the content of the other web sites visited by the user, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

In the Office Action, the Examiner at least admitted that *Mitchell* did not specifically teach the assigning of a unique ID to each device among a plurality of devices. Instead the Examiner relied on *Haitsuka* to teach this feature and, more specifically, the Examiner relied on col. 2, lines 64-67 and col. 3, lines 1-3 of *Haitsuka*. Further, the Examiner stated with regard to *Haitsuka*, that a cookie is inherently known to contain device identification.

In response to a post-final remarks filed by Applicant, the Examiner has apparently confirmed a recognition that there is no express disclosure of the feature in *Haitsuka*, only maintaining that the subject matter of storing a unique ID for a user device in the cookie is "known inherently." Although the particular reasoning of the rejection is unclear, the Examiner is apparently relying on some "inherent" disclosure based on the particularly cited sections of *Haitsuka*.

It is well established that relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result

or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Applying this inherency standard to the cited section of *Haitsuka*, the subject matter of the Applicant's invention does not necessary follow that disclosure.

As disclosed in the cited sections of *Haitsuka*, cookies merely allow a server to record its own information about a user's specific information with respect to a particular website. *Haitsuka* discloses that a cookie is a mechanism that allows a web server to store its own information about a user on the user's own computer. (*Haitsuka*, col. 3, lines 7-9.) Cookies record a user's preferences with respect to a particular website. (*Haitsuka*, col. 3, lines 2-3.) This in and of itself does not render the claimed subject matter inherent as the claimed personalization of the website based on content of other websites and a unique ID for a user device is not a necessary result of that disclosure.

Although *Haitsuka* arguably teaches or implies storing user information in a cookie, there is no express or inherent disclosure for storing a unique ID for a user device in the cookie as suggested by the Examiner. That relied on language may be understood to merely disclose a cookie for a particular website containing user-specific information supplied by the user such as a cooking containing the phrase "interested in music." But such a user-specific preference recorded in a cookie may be common to millions of users on millions of computers. This would hardly necessarily constitute the assigning of a unique ID to each device among a plurality of devices as claimed. Simply put, the applied reference does not make clear that the missing descriptive matter is necessarily present in the reference, and that it would be so recognized by persons of ordinary skill.

As such, because *Haitsuka* fails to disclose a unique ID for a device, *Haitsuka* fails to disclose a step for assigning a unique ID to each device among a plurality of devices, as in claim 1 as relied upon by the Examiner.

Therefore, the particular combination of *Mitchell* and *Haitsuka* does not inherently or otherwise disclose the assigning of a unique ID to each device among a plurality of devices as claimed. Thus, independent claims 1 and 15 are believed to be distinguishable from the applied prior art for at least these reasons. In sum, given the relied on references, the Examiner has not set forth a *prima facie* case of obviousness for these claims.

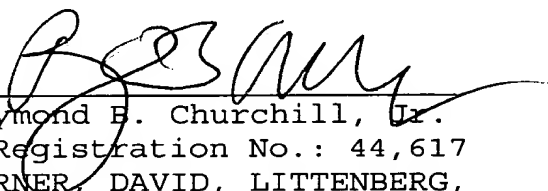
CONCLUSION

Applicant respectfully submits that claims 1 and 15 are not obvious in view of the applied combination of *Mitchell* and *Haitsuka*. Similarly, claims 2-14 and 16-18 which depend from one of claims 1 and 15 are not obvious at least due to such dependency in that they contain the unique and non-obvious subject matter of the independent claims that is not disclosed in the prior art. Accordingly, it is respectfully submitted that the Examiner erred in rejecting claims 1-18 and a reversal of such rejections by this Honorable Board is solicited.

Dated: September 11, 2006

Respectfully submitted,

By


Raymond E. Churchill, Jr.

Registration No.: 44,617

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

APPENDIX A - CLAIMS

1. A method of personalizing information presented at a host web site comprising:

assigning a unique ID to each device among a plurality of devices used for presenting the personalized information;

using the host web site for obtaining personal data about a user during a visit to the host web site;

after the host web site obtains the personal data about the user, using the host web site for monitoring the content of information viewed by the user while the user visits other web sites; and

during a subsequent visit by the user to the host web site, personalizing the information presented to the user, wherein the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the personal data obtained about the user and the content of the other web sites visited by the user, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

2. The method as claimed in claim 1, wherein the content of the information presented to the user during the subsequent visit to the host web site is related to the personal data obtained from the user.

3. The method as claimed in claim 1, further comprising obtaining authorization from the user to monitor the other web sites visited by the user.

4. The method as claimed in claim 1, further comprising:
placing a cookie on a hard disk of the user; and

recording the personal data about the user and the content of the other web sites visited by the user on the cookie.

5. The method as claimed in claim 4, further comprising retrieving from the cookie the personal data of the user and the content of the other web sites visited by the user.

6. The method as claimed in claim 5, wherein the personal data of the user and the content of the other web sites visited by the user are retrieved from the cookie during each subsequent visit to the host web site.

7. The method as claimed in claim 2, further comprising continuously updating the content of the information presented to the user during each subsequent visit to the host web site, wherein the content of the information is updated in response to any changes in the personal data for the user or in the content of the other web sites visited by the user.

8. The method as claimed in claim 1, wherein the content of the other web sites visited by the user includes the URL addresses of the visited web sites.

9. The method as claimed in claim 1, wherein the content of the other web sites visited by the user includes the length of time spent viewing the other web sites.

10. The method as claimed in claim 1, wherein the content of the other web sites visited by the user includes the number of times the user visits each of the other web sites.

11. The method as claimed in claim 1, wherein the content of the other web sites visited by the user includes any applets that are downloaded from the other web sites visited by the user.

12. The method as claimed in claim 1, further comprising presenting the personalized information on a device selected from the group consisting of personal computers, a laptop computer, set top boxes, wireless phones, pagers and personal digital assistants.

13. The method as claimed in claim 1, wherein the personal data about the user includes any information used to identify the user as a unique individual.

14. The method as claimed in claim 13, wherein the personal data includes the user's name, address, zip code, occupation, phone number, education level, income, marital status, citizenship, home ownership status, age and health.

15. A method of personalizing information presented to a user of a host web site comprising:

assigning a unique ID to each device among a plurality of devices used for presenting the personalized information;

using the host web site for collecting identifying data about the user during a first visit to the host web site;

after the host web site collects the identifying data, using the host web site for monitoring the content of information viewed by the user while the user visits other web; and

during a subsequent visit by the user to the host web site, personalizing the information presented to the user, wherein the host web site modifies the content of the information presented

to the user based upon the unique ID of the device used to access the host web site, the identifying data collected about the user and the content of the other web sites visited by the user, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

16. The method as claimed in claim 15, further comprising:
placing a cookie on a hard drive of the user;
recording information related to the identifying data of the user and the content of the other web sites visited by the user on the cookie.

17. The method as claimed in claim 16, further comprising during each subsequent visit to the host web site, transferring the information recorded on the cookie to the host web site.

18. The method as claimed in claim 17, further comprising continuously updating the information recorded on the cookie.

Application No.: 09/726,973

Docket No.: SONY 3.0-027

APPENDIX B - EVIDENCE

None submitted.

Application No.: 09/726,973

Docket No.: SONY 3.0-027

APPENDIX C - RELATED PROCEEDINGS

None known.